

Remarks

Claim 2 has been canceled and its limitation has been added to claim 1. Claim 7 has been amended to clarify the claim language and correct the dependency in view of the cancellation of claim 2. Claim 9 has been amended to substitute a recitation of the features of plasmid pTrcHis2 for the pTrcHis2 plasmid name itself. Support for this amendment can be found in the specification at page 13, lines 24-26. Claim 11 has been amended to clarify the claim language and correct the multiple dependency. Claim 13 has been amended to clarify the claim language and provide the genotype of *E. coli* TOP10 cells in place of the name of those cells. The genotype is provided on the website of Invitrogen; a copy of the relevant page (catalog.invitrogen.com/index.cfm?fuseaction=viewCatalog.viewProductDetails&productDescription=589) is included as reference C13 listed on the PTO-1449 that accompanies the Information Disclosure Statement filed herewith.

Claims 3-6, 8, 10, 12 and 14-16, which do not correspond to the elected invention, have been canceled.

New claims 17-18 have been added. These claims correspond, respectively, to original claims 11 and 13 as these claims depended from claim 9.

Accordingly, claims 1, 7, 9, 11, 13, 17 and 18 are now pending.

A paragraph of the specification on page 2 has been amended to correct a typographical error in the accession number of the gene encoding the HN protein of NDV strain AF2240. Further corrections to paragraphs of the specification were made to correctly denominate trademarked goods.

Applicant also requests that the title be amended as provided above, in order to more accurately reflect the invention as now claimed.

No new matter has been added.

Objections to the Specification

The Examiner objected to the specification for its use of trademarks and the misspelling of "Invitrogen" on page 17. Applicant has corrected these defects by inserting the trademark indicia "®" or "™" as appropriate, by capitalizing all trademarks within the specification, and by correcting the spelling of Invitrogen in two places in the specification. Withdrawal of the objection to the specification is respectfully requested.

Objections to the Claims

The Examiner objected to claims 11 and 13 as in improper multiple dependent form. Applicant has amended these claims to correct the format. The subject matter of claims 11 and 13 is now contained in amended claims 11 and 13 as well as new claims 17 and 18.

The Examiner objected to claims 11 and 13 for the wording of the claim. The claims as amended are clear in that the *E. coli* cell is transformed with the recombinant expression plasmid.

The Examiner objected to claim 13 as reciting elements that lack antecedent basis in claim 11. Applicant has amended the claims to correct this defect.

The Examiner objected to claim 13 for the recitation in parentheses of a specific expression vector. Applicant has amended claim 13 to remove this recitation.

In view of the foregoing, withdrawal of the objections to the claims is respectfully requested.

Rejections Under 35 U.S.C. § 101

The Examiner rejected claims 1 and 2 as directed to non-statutory subject matter. Claim 1 has been amended to recite that an isolated nucleic acid molecule is claimed; claim 2 has been canceled. Applicant respectfully requests withdrawal of the rejection of the claims under 35 U.S.C. § 101.

Rejections Under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claims 9, 11 and 13 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, and as not enabled. Applicant has amended the claims to remove the recitation of the specific plasmid and to insert a generic description of the plasmid, which contains coding regions for a *myc* epitope and 6 His residues downstream of a multiple cloning site into which the isolated nucleic acid is inserted. These features were described in the application as filed, on page 13, lines 24-26.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. § 112, first paragraph.

Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 2, 7, 9, 11 and 13 under 35 U.S.C. § 112, second paragraph, as indefinite. Applicant has amended claim 1 to include the limitation of claim 2 (SEQ ID NO:1), indicating that full-length nucleic acid molecule comprises the nucleotide sequence set forth as SEQ ID NO: 1. Therefore, Applicant asserts that the claim as now amended is not indefinite, in that the full length sequence is recited in the claim; a part of this sequence would encode a part of the nucleocapsid protein.

In view of the amendment of the claims, Applicant respectfully requests reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. § 112, second paragraph.

Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 1 and 7 under 35 U.S.C. § 102(b), as anticipated by Peeters et al. (J. Virol. 73(6):5001-5009, 1999). The Examiner indicated that Peeters discloses a full-length cDNA clone of NDV and a plasmid containing this clone, as well as DNA fragments containing the NP gene cloned into an expression vector. According to the Examiner, Peeters anticipates the claims because the claims are not limited to a specific sequence.

Applicant has amended claim 1 to recite the sequence limitation (SEQ ID NO:1) of claim 2. Peeters does not disclose the sequence of SEQ ID NO:1. (As indicated by the Examiner, SEQ ID NO:1 is free of the prior art of record.) In addition, Peeters et al. used an avirulent NDV strain (La Sota), whereas Applicant used a virulent NDV strain, AF2240. The claims as now amended are distinct from the NDV sequences disclosed by Peeters. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. § 102(b) based on Peeters. .

The Examiner rejected claims 1, 7 and 11 under 35 U.S.C. § 102(b), as anticipated by Errington et al. (J. Gen. Virol. 78:2335-2339, 1997). The Examiner indicated that Errington discloses cloning of the NDV NP gene into an expression vector.

Applicant has amended claim 1 to recite the sequence limitation (SEQ ID NO:1) of claim 2. Errington does not disclose the sequence of SEQ ID NO:1. (As indicated by the Examiner, SEQ ID NO:1 is free of the prior art of record.) In addition, Errington et al. used an avirulent NDV strain (Ulster 2C), whereas Applicant used a virulent NDV strain, AF2240. The

claims as now amended are distinct from the NDV sequences disclosed by Errington. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. § 102(b) based on Errington.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
Yusoff et al., Applicant



John R. Van Amsterdam, Reg. No. 40,212
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, Massachusetts 02210
Telephone: (617) 646-8000

Attorney's Docket No. S1436.70007US00
Date: January 15, 2005
x01/15/05x